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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,422	07/23/2003	Gina L. Timmons	036806.00437	9168
<div>7590 03/01/2007 Louis C. Dujmich Ostrolenk, Faber, Gerb & Soffen, LLP 1180 Avenue of the Americas New York, NY 10036-8403</div>			<div>EXAMINER RANGREJ, SHEETAL</div>	
			<div>ART UNIT 3626</div>	<div>PAPER NUMBER</div>
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/01/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/625,422	Applicant(s) TIMMONS ET AL.	
	Examiner Sheetal R. Rangrej	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on July 23, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>07/23/2003 and 04/26/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

Prosecution History Summary

- Claims 1-21 are pending.

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant receives the priority date of September 30, 2002 from U.S. Provisional Patent Application No. 60/414,858.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "102", "202", and "302" have all been used to designate administrative and management regions; reference characters "106", "206", and "306" have all been used to designate administrative and management function; reference characters "104", "700", "1200a-1200c" have all been used to designate healthcare facilities; reference characters "712" and "902" have both been used to designate receive notification of credit memo status; reference characters "204" and "1000" have both been used to designate pharmacies; reference characters "908" and "1002" have both been used to designate receive CM request with customer service; reference characters "300", "900", and "1400" have all been used to designate customer service portion; reference characters "600", "800", "1300" have all been used to designate PCP; reference characters "400", "1100", and "1500" have all been used to designate processing center; reference characters "404" and "1412" have both been used to

designate organize data; and reference characters "414" and "1502" have both been used to designate electronic communications network. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 1100 and 1204a-1204c. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any

required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6, 12, 15, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Barber et al. (U.S. Patent No. 4,858,121).

6. As per claim 1, Barber teaches a method for improving the accuracy of monetary charges to payors in a transaction (**Barber: column 1, lines 61-63**), comprising the steps of: (a) collecting census data from at least one first source (**Barber: column 4, lines 25-27; column 8, lines 21-25; the examiner considers Barber's patient information and demographic information to be a form of "census data"**) by means of an electronic communications network (**Barber: column 3, lines 26-41**); (b) collecting transaction data from at least one second source (**Barber: column 5, lines 31-34**) by means of the electronic communications network (**Barber: column 3, lines 26-41**); (c) correlating the census data and the transaction data with existing payor contract data to form a related dataset (**Barber: column 4, lines 45-48; column 5, lines 12-17**); (d) validating the dataset for accuracy (**Barber: column 5,**

lines 34-35); and (e) allocating monetary charges to at least one payor based on the dataset (Barber: column 7, lines 30-41).

7. As per claim 2, the method of claim 1 is as described. Barber further teaches further comprising the steps of enabling at least one of the first and second source, by means of the electronic communications network, to: (a) access the dataset and the allocated charges (**Barber: column 4, line 57-column 5, line 20**); (b) compare the allocated charges with records maintained by the accessing source (**Barber: column 8, lines 41-48**); and (c) reconcile discrepancies between the first and second sources regarding the charges (**Barber: column 8, lines 58-61**).

8. As per claim 3, the method of claim 1 is as described. Barber further teaches further comprising the step of protecting the census data, the transaction data and the dataset from unauthorized access (**Barber: column 4, lines 59-63**).

9. As per claim 4, the method of claim 1 is as described. Barber further teaches further comprising the step of protecting the data and the dataset (**Barber: column 8, lines 14-20**) from unauthorized alteration (**Barber: column 9, lines 3-11**).

10. As per claim 5, the method of claim 1 is as described. Barber further teaches further comprising the step of generating reports from the dataset (**Barber: column 4, lines 48-50; column 12, lines 3-23**).

11. As per claim 6, the method of claim 5 is as described. Barber further teaches further comprising the step of compiling the dataset into predetermined report formats (**Barber: column 12, lines 3-23**).

12. As per claim 12, Barber teaches a method for improving the accuracy of monetary charges to payors in a transaction, comprising the steps of: (a) collecting census data from at least one first source (**Barber: column 4, lines 25-27; column 8, lines 21-25; the examiner considers Barber's patient information and demographic information to be a form of "census data"**) by means of an electronic communications network (**Barber: column 3, lines 26-41**); (b) collecting transaction data from at least one second source (**Barber: column 5, lines 31-34**) by means of the electronic communications network (**Barber: column 3, lines 26-41**); (c) correlating the census data and the transaction data with existing payor contract data to form a related dataset (**Barber: column 4, lines 45-48; column 5, lines 12-17**); (d) validating the dataset for accuracy (**Barber: column 5, lines 34-35**); (e) allocating monetary charges to at least one payor based on the dataset (**Barber: column 7, lines 30-41**); (f) enabling at least one of the first and second sources, by means of the electronic communications network, to: i. access the dataset and the allocated charges (**Barber: column 4, line 57-column 5, line 20**), ii. compare the charges with records maintained by the source (**Barber: column 8, lines 41-48**), and iii. reconcile discrepancies between the first and second sources regarding the charges (**Barber: column 8, lines 58-61**); and (g) generating reports from the dataset (**Barber: column 4, lines 48-50; column 12, lines 3-23**).
13. As per claim 15, the method of claim 1 is as described. Barber further teaches wherein the electronic communications network is used to transmit and receive

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messages between the first source, the second source, and a processing center

(Barber: column 3, lines 26-35). In light of the specification, the examiner interprets that the remote locations are first source, second source, and the processing center.

14. As per claim 18, the method of claim 5 is as described. Barber further teaches wherein the reports relate to the business performance of facilities and groups of facilities **(Barber: column 4, lines 54)**. In light of the specification, the examiner interprets Barber's teaching of "A printer may be provided for printing patient receipts, physician statements or reports...or the like", which also includes business performance and the physician's office to be the same as facilities. The examiner also interprets that expanding the application of the method does not change the method as a whole and therefore also be used equally by the claimed groups of facilities.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 7-10, 13-14, 16, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barber et al. (U.S. Patent No. 4,858,121) in view of Lilly et al. (U.S. Publication No. 2003/0093295).

17. As per claim 7, the method of claim 5 is as described. Barber does not teach further comprising the step of distributing the reports to predetermined users.

Lilly teaches further comprising the step of distributing the reports to predetermined users (**Lilly: paragraph 0066; paragraph 0068, lines 1-5**). In light of Lilly's teachings, the examiner interprets transactions of the like to include reports.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Barber and Lilly's teachings. One of ordinary skill would have been motivated to combine these teachings because Lilly discloses that "the industry has widely recognized a need for better efficiencies, without notable success in many areas...it would be desirable to reduce spiraling cost structures, mitigate health risks, provide more efficient billing and business modeling, eliminate redundancy, and improve informational flow, the solutions to such overwhelming problems are generally unavailable" (**Lilly: paragraph 0009**).

18. As per claim 8, the method of claim 7 is as described. Barber further teaches wherein the reports (**Barber: column 12, lines 3-23**) are distributed via the electronic communications network (**Barber: column 3, lines 26-41**).

19. As per claim 9, the method of claim 7 is as described. Barber does not teach further comprising the step of classifying the dataset and reports into predetermined access levels for controlling the extent of access to the dataset and reports by the predetermined users.

Lilly teaches further comprising the step of classifying the dataset and reports into predetermined access levels for controlling the extent of access to the dataset and reports by the predetermined users (**Lilly: paragraph 0066; paragraph 0068**). In light of the Applicant's specification, the examiner interprets that the dataset and reports are classified into predetermined access levels due to there being a predetermined access levels for predetermined users.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Barber and Lilly's teachings. One of ordinary skill would have been motivated to combine these teachings because Lilly discloses that "the Healthcare Information Portability and Accountability Act (HIPAA) mandates the exchange of information more ubiquitous, secure, and efficient" (**Lilly: paragraph 0009, lines 3-7**).

20. As per claim 10, the method of claim 5 is as described. Barber does not teach further comprising the step of protecting the reports from unauthorized access.

Lilly teaches further comprising the step of protecting the reports from unauthorized access (**Lilly: paragraph 0066-0067**).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Barber and Lilly's teachings. One of ordinary skill would have been motivated to combine these teachings because Lilly discloses that "the Healthcare Information Portability and Accountability Act (HIPAA)

mandates the exchange of information more ubiquitous, secure, and efficient" (**Lilly: paragraph 0009, lines 3-7**).

21. As per claim 13, the method of claim 1 is as described. Barber further teaches wherein the first source further comprises a hierarchy of individual facilities (**Barber: column 3, lines 30-31**)

Barber does not teach facility groups comprising a plurality of individual facilities and corporate oversight of the facilities and groups of facilities.

Lilly teaches facility groups comprising a plurality of individual facilities (**Lilly: paragraph 0052, lines 1-2, i.e. many different types of entities/organizations**) and corporate oversight of the facilities and groups of facilities (**Lilly: paragraph 0054, lines 1-2, i.e. CDC**).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Barber and Lilly's teachings. One of ordinary skill would have been motivated to combine these teachings because Lilly discloses that "the industry has widely recognized a need for better efficiencies, without notable success in many areas" (**Lilly: paragraph 0009, lines 1-3**).

22. As per claim 14, the method of claim 1 is as described. Barber does not teach wherein the second source further comprises a hierarchy of individual pharmacies, pharmacy groups comprising a plurality of individual pharmacies, and corporate oversight of the pharmacies and groups of pharmacies.

Lilly teaches wherein the second source further comprises a hierarchy of individual pharmacies (**Lilly: paragraph 0052**), pharmacy groups comprising a plurality of individual pharmacies (**Lilly: paragraph 0052**), and corporate oversight of the pharmacies and groups of pharmacies (**Lilly: paragraph 0054, lines 1-2, i.e. DEA**).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Barber and Lilly's teachings. One of ordinary skill would have been motivated to combine these teachings because Lilly discloses that "the industry has widely recognized a need for better efficiencies, without notable success in many areas" (**Lilly: paragraph 0009, lines 1-3**).

23. As per claim 16, the method of claim 1 is as described above. Barber does not teach further comprising the steps of: (a) conducting logical queries using the dataset; and (b) analyzing the results of the logical queries.

Lilly teaches further comprising the steps of: (a) conducting logical queries using the dataset (**Lilly: paragraph 0070, lines 1-7; claim 8**); and (b) analyzing the results of the logical queries (**Lilly: paragraph 0071**).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Barber and Lilly's teachings. One of ordinary skill would have been motivated to combine these teachings because Lilly discloses that "prescriptions have risen more than 50%" (**Lilly: paragraph 0010**) making it hard to search and find it in databases.

24. As per claim 19, the method of claim 15 is as described. Barber does not teach further comprising the steps of: (a) conducting a survey via the electronic communications network; (b) obtaining responses to the survey via the electronic communications network; (c) taking corrective action to resolve problems identified by the survey.

Lilly teaches further comprising the steps of: (a) conducting a survey via the electronic communications network (**Lilly: paragraph 0053, lines 13-18**); (b) obtaining responses to the survey via the electronic communications network (**Lilly: paragraph 0053, lines 13-18**); (c) taking corrective action to resolve problems identified by the survey (**Lilly: paragraph 0054**).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Barber and Lilly's teachings. One of ordinary skill would have been motivated to combine these teachings because Lilly discloses that the prior art "does not provide a solution with respect to prescription tracking and abuse" (**Lilly: paragraph 0009, lines 6-7**).

25. As per claim 20, the method of claim 15 is as described. Barber does not teach further comprising the steps of transmitting and receiving communications between the first source and the second source regarding interest in particular new products and the performance of current products.

Lilly teaches further comprising the steps of transmitting and receiving communications between the first source and the second source regarding interest in

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particular new products and the performance of current products (**Lilly: paragraph 0055**).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Barber and Lilly's teachings. One of ordinary skill would have been motivated to combine these teachings because Lilly discloses that "pharmaceutical companies and researchers are in a constant race to provide the public with pharmacological formulations that are compatible with constantly evolving therapeutic formulations..." (**Lilly: paragraph 0055, lines 1-6**).

26. Claims 11, 17, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barber et al. (U.S. Patent No. 4,858,121) in view of Oscar et al. (U.S. Publication No. 2001/0037216) and further in view of Lilly et al. (U.S. Publication No. 2003/0093295).

27. As per claim 11, the method of claim 5 is as described. Barber and Lilly do not teach wherein patient-identifying information has been removed from the dataset.

Oscar teaches wherein patient-identifying information has been removed from the dataset (**Oscar: paragraph 0057, lines 18-22**).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Barber and Oscar's teachings. One of ordinary skill would have been motivated to combine these teachings because Lilly discloses that "the Healthcare Information Portability and Accountability Act (HIPAA)

mandates the exchange of information more ubiquitous, secure, and efficient” (**Lilly: paragraph 0009, lines 3-7**).

28. As per claim 17, the method of claim 5 is as described. Barber and Lilly do not teach wherein the reports relate to the business performance of pharmacies and groups of pharmacies.

Oscar teaches wherein the reports relate to the business performance of pharmacies and groups of pharmacies (**Oscar: paragraph 0058, lines 5-6 and lines 12-18**). The examiner interprets that expanding the method’s application does not change the method as a whole and therefore also be used equally by the groups of pharmacies.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Barber and Oscar’s teachings. One of ordinary skill would have been motivated to combine these teachings because Lilly discloses that “more than sixty percent of medical examiner cases are related to prescription drugs” creating a need for reports (**Lilly: paragraph 0003, lines 5-7**).

29. As per claim 21, the method of claim 15 is as described. Barber further teaches (a) generating reports from the dataset (**Barber: column 4, lines 48-50; column 12, lines 3-23**).

Barber and Oscar do not teach (b) distributing the reports to predetermined users via the electronic communications network; (c) classifying the dataset and reports into predetermined access levels for controlling the extent of access to the dataset and

reports by the predetermined users; (d) protecting the reports from unauthorized access.

Lilly teaches (b) distributing the reports to predetermined users via the electronic communications network (**Lilly: paragraph 0066; paragraph 0068, lines 1-5**).

The examiner interprets transactions of the like to include reports; (c) classifying the dataset and reports into predetermined access levels for controlling the extent of access to the dataset and reports by the predetermined users (**Lilly: paragraph 0066; paragraph 0068**). The examiner interprets that the dataset and reports are classified into predetermined access levels due to there being a predetermined access levels for predetermined users; (d) protecting the reports from unauthorized access (**Lilly: paragraph 0066-0067**).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Barber and Lilly's teachings. One of ordinary skill would have been motivated to combine these teachings because Lilly discloses that "the industry has widely recognized a need for better efficiencies, without notable success in many areas...it would be desirable to reduce spiraling cost structures, mitigate health risks, provide more efficient billing and business modeling, eliminate redundancy, and improve informational flow, the solutions to such overwhelming problems are generally unavailable" (**Lilly: paragraph 0009**) and that "the Healthcare Information Portability and Accountability Act (HIPAA) mandates the exchange of

information more ubiquitous, secure, and efficient" (**Lilly: paragraph 0009, lines 3-7**).

Barber and Lilly do not teach (e) removing patient-identifying information from the dataset.

Oscar teaches (e) removing patient-identifying information from the dataset (**Oscar: paragraph 0057, lines 18-22**).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine Barber in view of Oscar with Lilly. One of ordinary skill would have been motivated to combine these teachings because Lilly discloses that "the Healthcare Information Portability and Accountability Act (HIPAA) mandates the exchange of information more ubiquitous, secure, and efficient" (**Lilly: paragraph 0009, lines 3-7**).

Contact

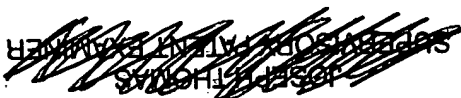
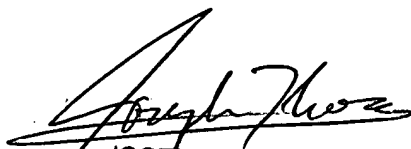
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheetal R. Rangrej whose telephone number is 571-270-1368. The examiner can normally be reached on Monday-Thursday from 8 a.m.-5 p.m. and every other Friday from 8 a.m. to 4 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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SRR

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2/20/07
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